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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,454	11/20/2001	Thomas Wirycz	7189	2430

29602 7590 11/27/2006

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,454

Applicant(s)

WIRYCZ ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-20 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-20, 24-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 5-20, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund, U.S. Patent No. 6,291,011 in view of Melber, U.S. Patent No. 4,902,722 as set forth in paragraph 3 of the previous action. With regard to new claim 25, Melber teaches microspheres in the claimed amount at col. 6, lines 61-63 and binder in the claimed amounts at table 1 and in example 1. With regard to claim 26, Edlund teaches drying the fiberglass fabric and collecting on a roll. See col. 4, lines 18-21.
3. Claims 1-3, 5-20, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund, U.S. Patent No. 6,291,011 in view of Schwartz et al, U.S. patent No. 4,433,022 as set forth in paragraph 4 of the previous action. With regard to claim 25, Schwartz teaches that the binder is present in an amount of about 64 percent and the microspheres are present in an amount of about 32 percent. See col. 4, lines 39-45. With regard to claim 26, Edlund teaches drying the fiberglass fabric and collecting on a roll. See col. 4, lines 18-21.
4. Applicant's arguments filed 9/19/06 have been fully considered but they are not persuasive. Applicant argues that Edlund does not teach the claimed step of providing a three dimensional decorative foamed pattern by heating a mixture of expandable chemicals, and that there is no motivation to combine the teaching of Melber with the teaching of Edlund, since Edlund intends to paint the surface rather than form a decorative foamed pattern on the glass surface. However, Edlund, Melber and

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Schwartz are concerned with forming decorative materials. Melber teaches selectively applying the mixture to a variety of substrates in order to impart a decorative appearance to the substrate as does Schwartz. Therefore, the person of ordinary skill in the art would have been motivated to apply the coating of Melber or Schwartz to the substrate of Edlund with the expectation that this would further enhance the decorative appearance of the wallcovering of Edlund.

5. Applicant argues that applying the coating of Melber or Schwartz to the conditioned wallcovering of Edlund would cover the hydrophilic areas which would prevent the substrate of Edlund from being able to be painted which is the objective of the material of Edlund. However, the coating of Melber or Schwartz already comprises pigments and other coloring agents, so it would not be necessary to paint over the coating of Melber. Further, there is nothing to show that paint could not be applied over the coating of Melber or Schwartz if desired. Finally, it is noted that Edlund intends to create a substrate to which decorative material can be applied. Melber and Schwartz each teaches a decorative material which can comprise dyes and pigments and which can be applied to substrates in order to decorate them. Therefore, to apply the decorative coating of Melber or Schwartz to parts of the substrate of Edlund would not be contrary to the invention of Edlund, since there is nothing to show that paint could not be applied to the coating of Melber or Schwartz and since the coating can be selectively applied which would leave other portions of the Edlund material without coatings where paint could be applied.

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6. Applicant argues that there is no motivation in the cited art to make the combination set forth in the art rejection. However, all three references relate to applying decorative coatings onto substrates in order to enhance their appearance. Melber teaches a three dimensional coating which would impart a textured decoration onto a substrate. Schwartz also teaches a three dimensional decorative coating which can be applied onto a glass fabric. Therefore, the motivation to make the combination would come from the fact that Edlund teaches a substrate onto which decorative coatings can be applied and Melber and Schwartz teach particular decorative coatings which can be applied to substrates in order to impart a textured, aesthetically appealing decoration onto the substrate.

7. Applicant argues that Melber does not teach a binder. However, example 1 of Melber teaches that the binder is an acrylic latex. See example 1, col. 9, lines 1-34. Melber teaches that the binder is present in an amount of 27 percent.

Applicant argues that the formulations of Melber do not "consist essentially of" the binder and the expandable microspheres. However, "for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). MPEP 2111.03 Also, If an applicant contends that

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additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Therefore, the burden is on Applicant show the introduction of additional steps of components in the formulations of Melber would materially change the characteristics of Applicant's invention.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Elizabeth M. Cole", is positioned above the printed name.

Elizabeth M. Cole
Primary Examiner
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e.m.c